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ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)  
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EXAMINER
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RUDY, ANDREW J

ART UNIT	PAPER NUMBER
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3627

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07/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/710,543	Applicant(s) SINGH ET AL.	
	Examiner Andrew Joseph Rudy	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 30-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 30-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-10 and 30-48 are pending. Applicant cancelled claims 11-29.

In view of the Appeal Brief filed on March 19, 2007, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below adjacent to Examiner Andrew Joseph Rudy's signature at the end of this Office Action.

### **(I) The Examiner's Prima Facie Case**

#### **a. Claim Construction**

2. The first step in establishing a prima facie case of anticipation is construing the claims. Claim construction is a question of law. *Cybor Corp. v. FAS Techs., Inc.*, 138

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F.3d 1448, 1454, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc). Additionally, “[i]t is the *claims* that measure the invention. [Emphasis in original.]” *Johnson & Johnston Associates Inc. v. R.E. Service Co.*, 285 F.3d 1046, 1052, 62 USPQ2d 1225, 1228 (Fed. Cir. 2002) (en banc) (citations omitted). The en banc court in *Johnson & Johnston Associates* noted that not only did the claims legally define the invention, the claims also provided the necessary notice regarding the scope of protection.

Both the Supreme Court and this court [the Federal Circuit] have adhered to the fundamental principle that claims define the scope of patent protection. The claims thus give notice of the scope of patent protection. The claims give notice both to the examiner at the U.S. Patent and Trademark Office during prosecution, and to the public at large, including potential competitors, after the patent has issued.

Consistent with its scope definition and notice functions, the claim requirement presupposes that a patent applicant defines his invention in the claims, not in the specification. *Johnson & Johnston Associates*, 285 F.3d at 1052, 62 USPQ2d at 1228-29 (citations omitted).

3. Next, when construing claims “[t]he general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).<sup>1</sup> In other words, “there is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.” *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (citations omitted).

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<sup>1</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustomed meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

4. It must be noted that to overcome this “heavy presumption” in favor of the ordinary and accustomed meaning, a party must do so by ‘clear and convincing’ evidence. Because the use of a “presumption” alone implies just a ‘preponderance of the evidence,’ it is the Examiner’s position that the use of the terms “heavy presumption” or “strong presumption” implies a standard *higher* than a preponderance. In other words, if e.g. a party needed only ‘preponderance of the evidence’ to invoke lexicography, the Federal Circuit would have simply used ‘presumption’ instead of “heavy presumption.” So that the word “heavy” or “strong” is not vitiated, the standard for lexicography invocation must be at least *greater than* a ‘preponderance of the evidence.’ And because ‘clear and convincing evidence’ is the next standard above ‘preponderance of the evidence,’ logic dictates that the standard for lexicography invocation (at least inter partes litigation) must be ‘clear and convincing evidence.’

**(i) During Ex Parte Examination – A Distinction With A  
Difference**

5. As noted continuously by the Examiner throughout the prosecution of this application, during ex parte examination, claims are given their “broadest reasonable interpretation . . . consistent with the specification.” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

6. In fact, the requirement that an examiner interpret the claims with the “broadest reasonable interpretation” is not optional; “an examiner has the *duty* to police claim

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language by giving it the broadest reasonable interpretation . . . . [Emphasis added.]”

*Spring Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 994, 65 USPQ2d 1826, 1830 (Fed. Cir. 2003) (citations omitted).

7. While the Examiner noted above that the ‘clear and convincing’ standard is the standard need to invoke lexicography during inter partes litigation, logic dictates that is it is also the standard for lexicography invocation and thus deviation from a term’s “broadest reasonable interpretation” during ex parte examination.

8. Consistent with *Morris*, the “broadest reasonable interpretation” of a term used during ex parte examination includes but is not limited to, all of the term’s ordinary and accustomed meanings. In fact, in ex parte cases, the Federal Circuit sometimes interchanges or substitutes “broadest reasonable interpretation’ with ‘ordinary and accustomed meaning.’ See e.g. *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the *broadest reasonable meaning* to the claim language . . . . Words in a claim are to be given their *ordinary and accustomed meaning* unless the inventor chose to be his own lexicographer in the specification. [Emphasis added.]”).

9. Moreover, arguments that the ‘clear and convincing evidence’ standard for lexicography invocation arises only after issuance and thus applies only to the inter partes litigation (*i.e.* ‘ordinary and accustomed meaning’) are not persuasive. The Examiner agrees that 35 U.S.C. §282 bestows a presumption of *validity* on issued patents. Therefore differing standards arise for *validity* (or invalidity) purposes only. See e.g. *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985) (“From *In*

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*re Etter*, 756, F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (en banc), it is apparent that, due to 35 U.S.C. §282, the standard of proof required to properly reject the claims of a patent application is necessarily lower than that required to invalidate patent claims"). However as noted earlier, claim construction is a question of law and is not necessarily a *validity* determination. Therefore 35 U.S.C. §282 can not change the standard for claim construction. In other words, §282 can not bestow any deference between two valid claim constructions. Because 35 U.S.C. §282 can not change the standard for claim construction, if 'clear and convincing evidence' is the standard used during inter partes litigation to determine if an applicant desires to be his or her own lexicographer, the Examiner concludes that 'clear and convincing evidence' is the standard needed to invoke lexicography during to ex parte examination.

#### **(ii) In Light of the Specification**

10. It is equally important to remember that although the claims are interpreted in light of the specification—or as in *Morris*, *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), consistent with the specification—limitations from the specification are not read into the claims. However the familiar canons of claim construction must be secondary to the fundamental principle that the claim defines the scope of patent protection, *Johnson & Johnston Associates*, 285 F.3d at 1052, 62 USPQ2d at 1228-29 (citations omitted). Thus, the issue of understanding the role of the specification in construing the claims has become especially confusing and the subject of much litigation. Circuit Judge Dyk even acknowledged this confusion when he

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stated that “our decisions provide inadequate guidance as to when it is appropriate to look to the specification to narrow the claim by interpretation and when it is not appropriate to do so. Until we provide better guidance, I fear that the lower courts and litigants will remain confused.”

11. As in *Teleflex*, the Federal Circuit has restricted the importation of the specification into the claims in some situations while, on the other hand, allowed importation of the specification into the claims in other situations. As a result, these claim misinterpretations continue and become at least one factor (if not a significant factor) in the lack of claim construction predictability. One commentator has suggested that implicit in this lack of claim construction predictability is the conclusion that the reversal rate is far too high for the legal and business communities to have confidence in the predictability of patent infringement lawsuits. In turn, this lack of confidence tends to degrade the entire patent system and one of the pillars upon which our entire intellectual property system is based.

As Professor Moore suggested, practitioners have experimented and attempted to bring order and predictability to this area of patent law. For example, one attempt cautions that should the current trend continue, “patentees and third parties may be unable to ascertain, with any degree of accuracy, the scope of their patent.” Others have attempted to break claim interpretation into two main approaches: a “statutory approach” and a “confirmation approach” and call the current doctrine “unsatisfactory.” The confusion however continues. As a result, applicants frequently resort to the “in



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light of the specification argument” when the words of the claims themselves are no longer adequate to support their proffered interpretation.

### **(A) The Solution**

12. When construing “in light of the specification,” “consistent with the specification,” “with a view to ascertaining the invention,” “looking to the specification to construe claim terms,” and other similar language, there exists four ways, methods, or factors an applicant or patentee can read the specification into the claims. If an applicant or patentee does not comport his or her arguments into one of the four ways or methods as outlined below, as a matter of law, the phrases “in light of the specification,” “consistent with the specification,” “with a view to ascertaining the invention,” and other similar phrases will have no patentable significance in claim construction. For example, the “looking to the specification to construe claim terms” as stated *Interactive Gift Express, Inc. v. CompuServe, Inc.*, 256 F.3d 1323, 59 USPQ2d 1401, 1407 (Fed. Cir. 2001) means that a reviewing body should look to the specification to see if one of the four methods of reading the specification into the claims as outlined below are present in the case. If none of the four factors are present, it is improper to read the specification into the claims.

Finally, while all four factors are clearly available in inter partes litigation (e.g. a patent infringement suit), the Examiner will show that only Factors #1 and #4 are available during ex parte examination. While a district court may look at a single patent case within a two week time frame allowing the court ample time to investigate all four

factors, this is not the case at the USPTO. The administrative process at the USPTO—where thousands and thousands of claim interpretations are done every day—demands a predictable, consistent, and easily applicable rule which will add certainty to the claim interpretation process.

**(B) The 4 Exceptions: 4 Ways to Get the Specification into the Claims**

13. There are four (4) ways or methods (hereinafter “factors”) of reading the specification into the claims. Unless an applicant or patentee can utilize one or more of the these four factors, it is improper to read the specification into the claims.

[We] ... may constrict the ordinary meaning of a claim term in at least one of four ways. First, the claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history. . . . Second, a claim term will not carry its ordinary meaning if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention. . . . Third, . . . a claim term also will not have its ordinary meaning if the term chosen by the patentee so deprives the claim of clarity as to require resort to the other intrinsic evidence for a definite meaning. . . . Last, as a matter of statutory authority, a claim term will cover nothing more than the corresponding structure or step disclosed in the specification, as well as equivalents thereto, if the patentee phrased the claim in step- or means-plus-function format. *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67, 62 USPQ2d 1658, 1662-63 (Fed. Cir. 2002) (citations and internal quotations omitted).<sup>2</sup>

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<sup>2</sup> The four methods enumerated in *CCS Fitness* are really not new. *CCS Fitness* however was one of the first Federal Circuit cases to clearly and succinctly enumerate all four factors in a single case. For this reason, the Examiner will henceforth refer to these factors, methods, or ways, as “the Four *CCS Fitness* Factors” or the “the Four *CCS Fitness* Methods.”

### I. CSS Fitness Factor #1: Lexicography

14. "It is black letter law that a patentee can choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning." *Jack Gluttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1360, 64 USPQ2d 1302, 1307 (Fed. Cir. 2002) (citations and quotations omitted). "In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204, 64 USPQ2d 1812, 1819 (Fed. Cir. 2002) (a claim's ordinary meaning, which in this case was a dictionary definition, is overcome if patentee is acting as their own lexicographer).

15. There are many two (2) primary reasons for invoking lexicography. First, an applicant may use lexicography when he or she is unsure of a term's meaning or when an applicant desires to define an entirely new term. "This is done in order to hold open the possibility of obtaining a patent where an inventor is not schooled in the terminology of the technical art to which his invention pertains or where there is a need to coin new expressions with which to communicate that invention." *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1031 (Fed. Cir. 1984)(citations omitted).

17. Second and more commonly, lexicography may be used to *redefine* a claim term which already possesses a clear, ordinary and accustomed meaning. "But even where the claim language is not ambiguous, the prosecution history limits the interpretation . . . . Thus, the prosecution history limits even clear claim language . . . ." *Schumer v*

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*Laboratory Computer Systems, Inc.*, 308 F.3d 1304, 1313, 64 USPQ2d 1832, 1839

(Fed. Cir. 2002) (citations and quotations omitted).

18. This 'redefined term' or lexicographic definition is not limited by known usages either. The redefined term or lexicographic definition may be *contrary to* or *inconsistent with* one or more of the term's ordinary meanings. "It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings." *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990). The redefined term or lexicographic definition may also *expand* or *further limit* the known ordinary and accustomed meanings. "A patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant art, thereby expanding or limiting the scope of the term in the context of the patent claims." *Alloc Inc. v. ITC*, 68 USPQ2d 1161, 1165 (Fed. Cir. 2003).

19. A redefined term or lexicographic definition is of particular importance during *ex parte* examination because it is the *primary* way to overcome the broadest reasonable interpretation. In other words, when an applicant acts as his or her own lexicographer and successfully redefines a claim to have a meaning other than its ordinary and accustomed meaning, the claims must be examined using that meaning. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("When the Applicant states the meaning that the claim terms are intended to have, the claims are examined

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with that meaning, in order to achieve a complete exploration of the Applicant's invention and its relation to the prior art.”).

20. To that end and with the ‘clear and convincing evidence’ standard noted above, it is appellants’ burden to overcome the ordinary and accustomed meaning or broadest reasonable interpretation. “[A] party wishing to alter the meaning of a clear claim term must overcome the presumption that the ordinary and accustomed meaning is the proper one, demonstrating why such an alteration is required.” *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 52 USPQ2d 1001, 1004 (Fed. Cir. 1999)(citations omitted). With lexicography in particular, this means that appellants must demonstrate that they have redefined the claim term with the required clarity, deliberateness, and precision. “The patentee’s lexicography must, of course, appear ‘with reasonable clarity, deliberateness, and precision’ before it can affect the claim.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). In our case, Factor #1 is not at issue. In other words, it is the Examiner’s conclusion that Appellants are not, or more precisely, were not their own lexicographer. In this case, because Appellants have not overcome the heavy presumption, lexicography does not apply. Because lexicography is the *primary* way to overcome the broadest reasonable interpretation, the Examiner has gone to great lengths to ensure that his conclusion regarding Factor #1 and lexicography invocation was proper.

**(D) Summary of “In Light of the Specification” Arguments**

21. In conclusion, *Morris* requires that the broadest reasonable interpretation be made “in light of the specification.” During ex parte examination, this means that the heavy presumption in favor of the “broadest reasonable interpretation” may be overcome by either (1) lexicography, or (2) the application of 35 U.S.C. §112 6<sup>th</sup> paragraph. In other words, lexicography and §112 6<sup>th</sup> paragraph are the only two exceptions to the rule that the claims be interpreted with their “broadest reasonable interpretation.” In this case, the Examiner has concluded (1) that Appellants are not their own lexicographer, and (2) that Appellants have failed to successfully rebutted the presumption that 35 U.S.C. §112 6<sup>th</sup> paragraph does *not* apply. Thus, the Examiner concludes that in this particular case, the phrase “consistent with the specification” as noted in *Morris* has no legal effect.

**(iii) The Transitional Phrase in Claim 1 is “Open”**

22. When a patent claim uses the word “comprising” as its transitional phrase, its use creates a presumption that the body of the claim is open. In the parlance of patent law, the transitional phrase “comprising” creates a presumption that the recited elements are only a part of the device, that the claim does not exclude additional, unrecited elements. See *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356, 55 USPQ2d 1835, 1839 (Fed. Cir. 2000). In other words, “[t]he transition ‘comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.” *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1364 (Fed. Cir.

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2003)(citations omitted). It is the Examiner's factual determination that claim 1 expressly states as a transitional phrase, "the method comprising . . ."

23. After considering all evidence of record, it is the Examiner's legal conclusion that because claim 1 uses the term "comprising," a presumption is established that the body of claim 1 is open. As of the date of this Answer, Appellants have offered no evidence (or even arguments for that matter) indicating that claim 1 should be considered anything other than 'open.' Because claim 1 is considered open, it may cover additional, unrecited steps. See *e.g. Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271, 229 USPQ 805, 812 (Fed. Cir. 1986)(when a claim uses an "open" transition phrase, its scope may cover devices that employ additional, unrecited elements). The Examiner therefore may add additional steps to support his conclusions of anticipation and obviousness.

#### **(iv) Broadest Reasonable Interpretation**

24. Having establishes that the only two exceptions to the rule do not apply (*i.e.*, the rule that the Examiner apply the "broadest reasonable interpretation" when interpreting the claims), *Morris* additionally states that the Examiner is now free to rely on *his* interpretation of claim terms (even if different from appellants) as long as he can point to reasonable sources that support his interpretation. "Absent an express definition in their specification [*i.e.* lexicography], the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition

unreasonable when the PTO can point to other sources that support its interpretation.”

*Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029.

#### **(A) Dictionaries as a ‘Other Sources’**

25. “It is well settled that dictionaries provide evidence of a claim term’s ordinary meaning. Such dictionaries include dictionaries of the English language, which in most cases will provide the proper definitions and usages, and technical dictionaries, encyclopedias and treatises, which may be used for established specialized meanings in particular fields of art.” *Inverness Medical v. Biomeditech Co.*, 309 F.3d at 1369, 64 USPQ2d at 1930. Even though e.g. “aggregating the restock quantities over the plurality of dispensing units” is not found ‘as written’ in a dictionary, this does not mean that the ordinary meaning of individual claim words should be ignored. In other words, “simply because a phrase as a whole lacks a common meaning does not compel a court to abandon its quest for a common meaning and disregard the established meanings of the individual words.” *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1372, 65 USPQ2d 1865, 1871 (Fed. Cir. 2003) (citations omitted).

#### ***Claim Rejections - 35 USC § 112***

26. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



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27. Claims 1-10 and 30-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 3, "reviewing existing direct sales processes to ensure current policy compliance" is not clear as to what constitutes direct sales processes nor what comprises current policy compliance.

Claim 1, line 5, "creating new screening processes to minimize commercial risk" is not clear not clear as to what constitutes new screening processes nor what comprises minimize commercial risk.

Claim 1, line 7, "integrating the existing direct sales screening processes and new screening processes" is not clear as to what constitutes integrating.

Claim 36, line 3, "considering impact of applicable regulatory regulations on electronic sales transactions" is not clear as to what constitutes applicable regulations.

Claim 40, line 5, "a list of prohibited transaction criteria" is not clear as to what constitutes such criteria.

Claim 40, lines 12, 13, "determine legal terms and conditions to associate with the medical device sale requests" is not clear as to what constitutes such criteria.

Applicant's March 19, 2007 REMARKS have been reviewed, but are not convincing.

The terms are deemed nebulous and lack clarity. If the terms are common knowledge and well known, Applicant is requested to affirmatively state such and provide

documentary evidence. If Applicant is their own lexicographer, evidence of such is requested. Otherwise, the claims are deemed indefinite.

***Claim Rejections - 35 USC § 103***

28. Claims 1-10 and 30-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buddle et al., US 6,912,502.

Buddle discloses, e.g. Figs. 1-7, an electronic media method for designing an electronic transaction system, where at step 12, existing regulations, laws, statutes, internal standards or policies, and other sources of compliance requirements, e.g. Federal, State, local, are reviewed and posted on the Internet. Official Notice is taken that the subject matter from claims 1-10 and 30-48 appears to be common knowledge business attributes. To have posted the common knowledge subject matter of these claims over an electronic media network, e.g. the Internet, would have been obvious for one ordinary skill in the art in view of Buddle and Official Notice.

KSR forecloses Applicant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Claims 1-10 and 30-48 recited combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. In addition, neither Applicant's Specification nor REMARKS present any evidence that modifying such was uniquely challenging or difficult for one of ordinary skill in the art. Because this is a case where the improvements are no more than predictable use of prior art elements according to

their established functions, no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396

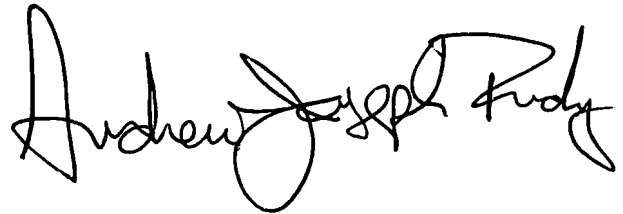
29. Further references of interest are noted on the attached PTO-892.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 571-272-6789. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan M. Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, reading "Andrew Joseph Rudy". The signature is fluid and cursive, with the first name "Andrew" being the most prominent.

Andrew Joseph Rudy  
Primary Examiner  
Art Unit 3627

A handwritten signature in black ink, reading "A. Fischer". To the right of the signature is the date "7/8/01".

ANDREW J. FISCHER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600